

**REMARKS**

Claims 1-12, 18-44, 49 and 52 are all the claims pending in the application.

I. Claim Rejections under 35 U.S.C. § 103

Claims 1-4, 7-10 and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bestmann (U.S. Patent No. 5,481,380), hereinafter “Bestmann” in view of Yeomans (U.S. Patent No. 4,866,514), hereinafter “Yeomans”.

For at least the following reasons, Applicants respectfully traverse the rejections.

Claim 1 recites, *inter alia*, producing a proof on which the difference between the color of said desired print medium and the color of said standard print medium has been corrected, on a proof medium with an image output device based on said second colorimetric data.

The Examiner contends that Bestmann discloses an element 6 in Fig. 1 as corresponding to the claimed image output device and an element 33 in Fig. 5 as corresponding to the claimed proof. See Office Action page 3. However, proof 33 is a test original, which contains a plurality of test colors. See Bestmann col. 8, lines 56-58. Applicants submit that the test original 33 is not produced by the element 6 in Fig. 1 of Bestmann. Further, the test original is not produced based on the second colorimetric data, which had undergone the conversions as claimed. The test original 33 is scanned to obtain R,G,B values, which are later converted to Lab values. See Bestmann col. 8, lines 56-65.

In addition, it is noted that Bestmann is only operable to take into account the electrical and optical properties between actual devices. See col. 2, lines 41-43. Bestmann fails to take into account any possible change of the standard medium and proof medium. In fact, Bestmann appears to be incapable of taking into account changes in material. See col. 10 last line to col. 11, first line.

At least for the reasons discussed above, Applicants submit that claim 1 is patentable.

Because independent claims 2, 7 and 8 include features similar to claim 1, claims 2, 7, and 8 are also patentable, at least for the reasons set forth above. The remaining claims depending from 1, 2, 7, and 8 are patentable at least by virtue of their dependency.

Claims 18-19, 21-22, 24-28 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bestmann (U.S. Patent No. 5,481,380) in view of Tse (U.S. Patent No. 5,477,345), hereinafter "Tse".

Independent claim 18 recites, *inter alia*, the color correcting means corrects the data based on the ratios of  $X\alpha/X0$ ,  $Y\alpha/Y0$  and  $Z\alpha/Z0$ , where  $X\alpha$ ,  $Y\alpha$  and  $Z\alpha$  are second colorimetric data values and  $X0$ ,  $Y0$  and  $Z0$  are first colorimetric data values for which the difference between the color of a desired print medium and the color of said standard print medium has been corrected.

The Examiner admits that Bestmann does not teach or suggest the above features of claim 18. To make up for the deficiencies of Bestmann, the Examiner cites Tse.

Applicants submit that Tse does not make up for the deficiencies of Bestmann. The Examiner cites to col. 11, lines 33-60 of Tse to teach the above features of claim 18.

The cited portion of Tse discloses a transform based on  $F(X/X_n)$ , etc. However,  $X/X_n$  do not correspond to first and second colorimetric data values for which the difference between the color of a desired print medium and the color of said standard print medium has been corrected.

Therefore, even assuming arguendo that the references Bestmann and Tse may be combined, their combination does not teach each feature of claim 18. Applicants request the Examiner to withdraw the rejection of claim 18 at least for the reasons discussed above.

Because independent claims 21 and 24 include features similar to claim 18, claims 21 and 24 are also patentable, at least for the reasons set forth above. The remaining claims depending from 18, 21, and 24 are patentable at least by virtue of their dependency.

With further regard to claim 28, this claim describes a printer profile used in conversion. Though the Examiner refers to Fig. 5, element 32 to teach this feature, this is the same element (Fig. 2 elements 14, 15) relied by the Examiner to teach the conversion that purportedly corresponds to the correction in the medium. See col. 8, lines 55-67. Thus, the Examiner has improperly double counted the sole conversion element of Bestmann to allegedly take into account conversion based on discrete criteria. There is no basis to conclude that the sole converter corrects for the factors described by claim 28.

Claims 20 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bestmann (U.S. Patent No. 5,481,380) in view of Tse (U.S. Patent No. 5,477,345) and Keating (U.S. Patent No. 5,619,434).

Applicants submit that Keating does not cure the deficiencies of Bestmann and Tse. Therefore, claims 20 and 23 are patentable at least by virtue of their dependency.

Claims 5-6, 11-12, 29-31, 33-35, 37-39 and 41-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bestmann (U.S. Patent No. 5,481,380) in view of Yeomans (U.S. Patent No. 4,866,514) and Keating (U.S. Patent No. 5,619,434) and Dundas (U.S. Patent No. 5,604,567), hereinafter “Dundas”.

Applicants submit that Yeomans, Keating and Dundas do not cure the deficiencies of Bestmann. Therefore, claims 5-6, 11-12, 29-31, 33-35, 37-39, 41-43 are patentable at least by virtue of their dependency.

II. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

  
Susan P. Pan  
Registration No. 41,239

Date: August 14, 2007